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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,055	09/22/2003	David M. Reilly	VI/96-001.D2.C.C.D.C	7280

21140 7590 08/17/2004

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EXAMINER

KENNEDY, SHARON E

ART UNIT PAPER NUMBER

3762

DATE MAILED: 08/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/668,055

Applicant(s)

REILLY ET AL. CN

Examiner

Sharon Kennedy

Art Unit

3762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>02172004</u> | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Information Disclosure Statement

Applicant will note that the PTO Form-892 merely lists the foreign references on applicant's PTO Form-1449. This is being done so that the references can be scanned into IFW.

Oath/Declaration

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because applicant does not claim priority to the continuation/divisional applications. The oath appears to be from the first filed application.

Election/Restrictions

This application contains claims directed to the following patentably distinct species of the claimed invention:

Embodiment 1: Figures 2-4;

Embodiment 2: Figures 6-7;

Embodiment 3: Figures 8, 9A, 9B, 10, 11;

Embodiment 4: Figures 12-13;

Art Unit: 3762

Embodiment 5: Figures 14-15;

Embodiment 6: Figures 16, 17A;

Embodiment 7: Figures 18-19.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Art Unit: 3762

During a telephone conversation with Gregory Bradley on August 3, 2003 a provisional election was made without traverse to prosecute the invention of Embodiments 4 and 5. Affirmation of this election must be made by applicant in replying to this Office action.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Objections

Claim 3 is objected to because of the following informalities: It is dependent on claim 51. The claim will be examined as if it depended from claim 1. Appropriate correction is required.

Double Patenting

Claims 1-9 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent No. 5,899,885. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of this application encompass the claims of the parent.

Art Unit: 3762

Claims 1-9 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 8-19 of U.S. Patent No. 6,371,938. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of this application encompass the claims of the parent.

Claims 1-4, 7-9 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 5,779,675. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of this application encompass the claims of the parent.

It is becoming customary to delay filing of the terminal disclaimers until after the claims are allowable. This is a burden on the examiner and the USPTO staff. Accordingly, applicant should either file the terminal disclaimers or present arguments thereagainst.

Claim Rejections - 35 USC § 102

Claims 1-4, 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Lindquist, US 3,997,085. The intended use recited in the preamble is not accorded patentable weight since the body of the claims recites a complete apparatus and does not rely on the preamble. Accordingly, although Lindquist is for dispensing calking material, it meets all the limitations of the claimed invention. Barrel 12 anticipates the claimed pressure jacket.

Allowable Subject Matter

Claims 5, 6 and 9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, and if the terminal disclaimers set forth above were filed.

The following is a statement of reasons for the indication of allowable subject matter: None of the prior art shows or suggests the second front member as claimed in claims 5 and 6, in combination with a pressure jacket that substantially encloses the syringe. In this regard, applicant's comments set forth in parent patent US 5,899,885 are incorporated herein. Regarding claim 9, it is tempting to combine the Sherbondy, US 2,602,571, caulk gun with the Lindquist '085 caulk gun, however, the Lindquist barrel is to be filled with caulking compound (column 4, lines 11-13). It would destroy the operation of the Lindquist reference to attempt to put the slotted holder on the front of the gun. Accordingly, there is no issue of obviousness.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kispert, US 1,157,552 is considered and applicant's comments set forth in parent patent, US 5,779,675, are incorporated herein. Essentially, applicant stated that Kispert glass cylinder 2 could not be considered a pressure jacket. Regarding Sherbondy, US 2,634,889, the jacket cylinder 14 cannot "substantially enclose" a syringe during operations. Hoskins, US

Art Unit: 3762

1,747,243 is distinguished because there is no disclosure or suggestion of the open front end.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharon Kennedy whose telephone number is 703/305-0154. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on 703/308-5181. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Sharon Kennedy
Primary Examiner
Art Unit 3762

Sek